

MAIL STOP APPEAL BRIEF-PATENTS
PATENT
2503-1193

**IN THE U.S. PATENT AND TRADEMARK OFFICE BEFORE
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Valentino MERCATI Conf. 7193

Application No. 10/564,100 Group 1791

Filed February 24, 2006 Examiner Michael Felton

PROCESS FOR OBTAINING TOBACCO LEAVES WITH A STANDARDIZED
NICOTINE CONTENT AND/OR IMPROVED COMBUSTIBILITY

REPLY BRIEF

MAY IT PLEASE YOUR HONORS:

This is a reply to the Examiner's Answer mailed March 8, 2011.

STATUS OF CLAIMS

Claims 1-23 and 41-46 have been canceled. Claims 24-40 and 47 are pending in the application and stand rejected, from which this appeal is taken.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The first ground for review on appeal is whether claims 24-36 and 47 are sufficiently unpatentable over KIERULFF et al. (USP 6,298,859) in view of WOCHNOWSKI et al. (USP 3,265,209) to support a rejection under 35 U.S.C. §103(a).

The second ground for review on appeal is whether claims 37-39 are sufficiently unpatentable over KIERULFF et al. in view of WOCHNOWSKI et al. and CLAPP et al. (USP 4,941,484) to support a rejection under 35 U.S.C. §103(a).

ARGUMENT

The present invention pertains to a process for treatment of tobacco leaves (*Nicotiana tabacum*). The process includes the following steps:

- a) drying and curing of the leaves;
- b) extraction of dried leaves with a solvent or mixture of solvents;
- c) re-drying of the extracted leaves; and
- d) elimination of the ribs.

At page 5, paragraph 4 the Appeal Brief argued: *"Accordingly, it is evident that the invention yields unexpectedly properties due to the specific process steps and the specific order in which they are carried out."*

However, the Response to Argument asserts: *"Although steps a, b, and c, cannot be performed in any other order, there is no indication that step d (the elimination of ribs) occurs at a specific stage in the process."*

However, one of skill in the art would recognize that the a) drying - b) extraction - c) re-drying cycle is the most

important in the process, and the elimination of ribs (which are merely woody material having few or no extractables) is of little import to the process except to be necessary to obtain a uniform product.

Thus the a-b-c steps which the Office has admitted are consecutive are clearly linked to the unexpected results of the present invention.

The Response to Arguments additionally asserts that the evidence provided in the specification does not indicate that the results are unexpected when compared to the closest prior art (Kierulff et al.).

However, the results set forth in the specification do show the advantages of the present invention in regards to the conventional art, and even if not a side-by-side comparison with Kierulff et al., they still have patentable weight. The results in the specification must be viewed in light of the failure or weakness of establishing the *prima facie* case.

Further, both the inability to establish *prima facie* obviousness and the unexpected results should be viewed synergistically as establishing patentability of the claimed invention. *"The determination of obviousness, vel non, requires that all the evidence be considered together . . . if rebuttal evidence of adequate weight is produced, a holding of prima*

*facie obviousness, being but a legal inference from previously uncontradicted evidence, is dissipated. The objective evidence of unobviousness is not evaluated for its 'separate knockdown ability' against the 'stonewall' of the *prima facie* case . . . but is considered together with all other evidence, in determining whether the invention is as a whole would have been obvious to a person of ordinary skill in the field of the invention."* (citations omitted). *Applied Materials Inc. v. Advanced Semiconductor Materials*, 98 F.3d 1563, 1574, 40 USPQ2d 1481, 1486 (Fed. Cir. 1996).

As was pointed out at the bottom of page 7 of the Appeal Brief, neither KIERULFF et al. nor WOCHNOWSKI et al. disclose or infer the first step of drying and curing the leaves before the extraction step is carried out. Indeed, there is no teaching in KIERULFF et al. or in WOCHNOWSKI et al. that the extraction is to be performed on previously dried and cured leaves. It is at least this failure of the applied art that must be weighed against the results set forth in the specification.

At the bottom of page 7 the Response to Arguments further asserts:

*Kierulff et al. appear to indicate that ribs are removed in the process, stating: "Preferably the tobacco material used as **a starting material** for the present invention **is the lamina portion** of the tobacco leaf"*

(col. 3, 6-8). Therefore, one reading this disclosure in combination with the teachings of Wochnowski et al it would found it obvious for to remove the ribs (leaving the lamina portion of the leaf) via the process of Wochnowski et al. (Emphasis added).

By this, Kierulff et al. is teaching that the stems are removed **before** the process. That is, the starting material of Kierulff et al. has less extraneous material and contains more active agents such as nicotine. In contrast, the present invention removes the stems at some point **during** the process. The quality of the end product is thus clearly unexpected in light of Kierulff et al.

Yet further, the Response to Arguments asserts that some of the arguments in the Appeal Brief are not set forth in the claims. Applicant believes that the instant claims are sufficient to distinguish over the applied art. However, it is noted that the claims can be further amended to better define over the prior art.

Conclusion

It is believed that the foregoing discussion underscores the impropriety of the rejections on appeal and supports the showing made in Appellant's main brief that those

rejections should be reversed. Such action is accordingly respectfully requested.

Respectfully submitted,

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